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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,248	08/03/2000	Wolfgang Maus	E-41007	1144
24131	7590	07/14/2004	EXAMINER	
LERNER AND GREENBERG, PA P O BOX 2480 HOLLYWOOD, FL 33022-2480			TRAN, HIEN THI	
			ART UNIT	PAPER NUMBER
			1764	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/632,248

Applicant(s)

MAUS, WOLFGANG

Examiner

Hien Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-15, 18, 19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-15, 18-19, 21-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3, 7-8, 12-15, 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Locker et al (6,077,483).

With respect to claims 1-2, 7-8, 12-14, 19, Locker et al discloses a catalytic exhaust gas purification device comprising:

a steel casing 16;

a monolithic ceramic honeycomb element 10 mounted in said casing 16;

a compensating layer disposed between said casing 16 and said honeycomb element 10;

said compensating layer comprising:

a swelling mat or intumescent mat 14 with border regions at risk from abrasion;

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an insulating layer 12 having a border and an inner region; said border of said insulating layer 12 having a thicker region 12A than said inner region; and said swelling mat 14 being disposed adjacent a side of said inner region of said insulating layer 12 facing away from said honeycomb element 10 and said thicker region 12A of said border of said insulating layer 12 covering said border regions of said swelling mat 14 at risk from abrasion (Fig. 2);

said compensating layer is wrapped around the honeycomb element 10 (col. 7, lines 15-53).

With respect to claims 3, 15, Locker et al discloses that the insulating layer contains ceramic material (col. 4, lines 15-40).

Instant claims 1-3, 7-8, 12-15, 19 structurally read on the apparatus of Locker et al.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. The art area applicable to the instant invention is that of catalytic converter.

One of ordinary skill in this art is considered to have at least a B.S. degree, with additional education in the field and at least 5 years practical experience working in the art; is aware of the state of the art as shown by the references of record, to include those cited by applicants and the examiner (*ESSO Research & Engineering V Kahn & Co*, 183 USPQ 582 1974) and who is presumed to know something about the art apart from what references alone teach (*In re Bode*, 193 USPQ 12, (16) CCPA 1977); and who is motivated by economics to depart from the prior art to reduce costs consistent with the desired product characteristics. *In re Clinton* 188 USPQ 365, 367 (CCPA 1976) and *In re Thompson* 192 USPQ 275, 277 (CCPA 1976).

6. Claims 6 and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Locker et al (6,077,483) in view of Ten Eyck (4,999,168).

Since it is unclear as to what structural limitation applicant is attempting to recite as set forth above, as best understood, the apparatus of Locker et al is substantially the same as that of the instant claims, but fails to disclose whether the swelling mat may swell upon absorbing water.

However, Ten Eyck discloses the conventionality of providing a swelling mat containing mica as that of the instant invention and therefore inherently swells upon absorbing water (col. 5, lines 40-44).

It would have been obvious to one having ordinary skill in the art to alternatively select an appropriate material for the swelling mat, such as mica, as taught by Ten Eyck in the

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apparatus of Locker et al on the basis of its suitability for the intended use as a matter of obvious design choice to obtain the desired supporting and insulating the catalyst element thereof, absence showing any unexpected results and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In *re Leshin*, 125 USPQ 416.

7. Claims 9-11, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Locker et al (6,077,483) in view of Santiago et al (4,344,922) and Ten Eyck (4,999,168).

The apparatus of Locker et al is substantially the same as that of the instant claims, but fails to disclose whether the compensating layer may be prefabricated segments.

However, Santiago et al and Ten Eyck disclose the conventionality of providing a compensating layer in form of prefabricated segment.

It would have been obvious to one having ordinary skill in the art to use the compensating layer in prefabricated segment form as taught by Santiago et al and Ten Eyck in the apparatus of Locker et al, on the basis of its suitability for the intended use as a matter of obvious design choice to obtain the desired supporting the catalyst element thereof, absence showing any unexpected results.

Response to Arguments

8. Applicant's arguments filed 5/5/04 have been fully considered but they are not persuasive.

Applicant argues that the barrier coating in Locker et al provides a rigid rather than resilient base against which the intumescent layer may more efficiently apply retention pressure while the instant mat may inherently be flexible, windable, foldable, compressible and may have

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the ability of damping and resilience. Such contention is not persuasive as the instant claims do not require the resilient base and also there is nothing recited in the instant claim to exclude the rigid base of Locker et al. It is unclear as to where it is disclosed in the instant specification that the instant mat possesses all of the above properties.

Applicant argues that in Locker et al, there is a large bonding surface and at least partially no separate surfaces exist between the coating and the substrate. That may be so. However, the language of the instant claims does not commensurate in scope with such argument, e.g. the language of the instant claims does not exclude the bonding surface nor require separate surfaces.

Applicant's arguments with respect to the gap and cavities and other things regarding to the insulating mat are noted. However, as set forth above, the language of the instant claims does not commensurate in scope with such argument.

Furthermore, the same comments with respect to a product-by-process claim set forth in the previous office action apply.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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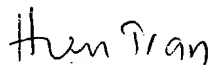
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hien Tran whose telephone number is (571) 272-1454. The examiner can normally be reached on Tuesday-Friday from 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HT
July 12, 2004


Hien Tran
Primary Examiner
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